

## **II. REMARKS**

### **A. REQUEST FOR RECONSIDERATION OF FINALITY OF OFFICE ACTION**

Applicants respectfully submit that the finality of the Office action is premature. In this Office action, the Examiner has introduced a new ground of rejection with respect to claims 11 and 16. The Office action sets out the rejection of claims 11 and 16 as being unpatentable over U.S. Patent 6,446,076 to Burkey et al. (Burkey) for the first time. The prior Office action mailed October 15, 2002, (2002 Office action) includes no explanation whatsoever regarding how Burkey renders claims 11 and 16 obvious. The explanation is provided for the first time in the instant Office action. Applicants request that the finality of the Office action be withdrawn such that applicants have a full and fair opportunity to respond to the rejection of claims 11 and 16 as being unpatentable over Burkey.

“[W]here the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on [new] information submitted in an information disclosure statement” an action need not be made final. M.P.E.P § 706.07(a) (8<sup>th</sup> Ed. 2001). Applicants made no amendments to the claims in response to the 2002 Office action. As a new ground of rejection has been asserted against claims 11 and 16 that has not been necessitated by applicants’ amendment, the finality of the Office action is premature.

### **B. 2002 OFFICE ACTION**

The 2002 Office action included a rejection of claims 11 and 16 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants filed a response January 15, 2003, (2003 Response) to the 2002 Office action that traversed this rejection without amendment to the claims. This response is acknowledged in Section 1 of the instant Office action. As the rejection under 35 U.S.C. § 112 has not been repeated in the instant Office action, applicants understand that it has been withdrawn.

### **C. RESPONSE TO REJECTIONS UNDER 35 U.S.C. § 103**

In Section 2 of the Office action, claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,446,076 issued to Burkey et. al (Burkey). The rejection presented in the recent Office action with regard to claims 1-10 and 12-15 is word for word identical to the rejection set forth in the 2002 Office action. An explanation of the rejection of claims 11 and 16 is added. Applicants set forth in detail the errors in the Examiner’s action in

the response filed January 15, 2003 (2003 Response). “Where the applicant traverses any rejections, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.” M.P.E.P. § 707.07(f) (8<sup>th</sup> Ed. 2001). The Examiner has failed to address the substance of applicants’ arguments. Accordingly, these arguments are repeated below. Applicants request that the Examiner address the substance of the arguments set forth below so that all outstanding issues are clearly developed before appeal. *See* M.P.E.P. § 706.07 (8<sup>th</sup> Ed. 2001)(“[T]he applicant is entitled to a full and fair hearing, . . . a clear issue between applicant and examiner should be developed, if possible, before appeal.)

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim recitations. M.P.E.P. § 706.02(j).

In order to support a rejection under 35 U.S.C. § 103 based on the modification of a single reference, the Office action must include specific evidence to show *why* one of ordinary skill would be motivated to modify the reference in such a way to incorporate all of the claimed elements. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000) (“Even when obviousness is based on a single prior art reference, there *must* be a showing of a suggestion or motivation to modify the teachings of that reference.”) (emphasis added). Broad conclusory statements concerning motivation to modify, standing alone, are not sufficient to support an obviousness rejection. *See In re Freed*, 425 F.2d 785, 787, 165 U.S.P.Q. 570, 571-72 (C.C.P.A. 1970) (an obviousness rejection must be based on facts, “cold hard facts”); *In re Kotzab*, 217 F.3d at 1370, 55 USPQ2d at 1317 (“Broad, conclusory statements standing alone are not ‘evidence.’”). Accordingly, a statement that a modification would be an “obvious design choice,” without factual support, is insufficient as a matter of law. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000). Finally, as the absence of a suggestion to modify a reference is dispositive in an obviousness determination, a rejection which fails to provide specific evidence as to *why* one of ordinary skill would be motivated to modify the relevant reference is insupportable, as a matter of law. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997).

As set forth in greater detail below, the rejection set forth in the Office action fails to meet the above requirements. In the Office action, it is acknowledged that many claim elements are not shown by Burkey. However, the Office action includes *only* broad conclusory statements that it would be obvious to modify Burkey to include elements taught only in applicants' specification. The Office action provides no specific evidence demonstrating why one of ordinary skill would be motivated to modify Burkey. Accordingly, the rejections of claims 1-16 under 35 U.S.C. § 103 should be withdrawn.

Burkey is directed to an information management system. Burkey generally describes personalization of information based on a user profile and based on where the user is logged onto the system. The invention defined by applicants' instant claims, relates to providing negotiation advice to a customer service representative (CSR) regarding an individual's economic situation. The instant invention is particularly useful for CSRs that are dealing with customers that are delinquent in paying recurring consumer debt payments. Burkey fails to include details related to the specific functions of applicants' claimed invention. There is no suggestion in the prior art to modify Burkey to address the provision of negotiation advice.

The rejections of claims 1-16 as being unpatentable over Burkey include a number of errors. The rejections mischaracterize the single applied reference, Burkey. The rejections imprecisely refer to the limitations of the pending claims. The rejections fail to identify any specific evidence of a suggestion or motivation to modify Burkey to arrive at the claimed invention. The rejections also fail to address all the elements of each pending claim.

### **1) Independent Claim 1 and Claims Depending Therefrom**

Independent claim 1 sets forth a system including a first graphical user interface (GUI) comprising one or more descriptive icons, the descriptive icons representing one or more financial situations. A second GUI is displayed on the display of a computer based on selection of one of the descriptive icons. A processor is operative to generate financial payment advice.

Burkey is mischaracterized in the instant Office action in the same manner as in the 2002 Office action. In the Office action it is implied that processor 110 of Burkey is operative to generate financial planning, healthcare, and personal and professional development advice. The Office action relies on column 28, line 34, through column 29, line 5, of Burkey. This section of Burkey is directed to a computer application providing users with personal web sites that are focused on delivering services in a buyer-centric world. Burkey, col. 28, ll. 34-38.

Burkey merely discloses that the services addressed are intuitively organized around objectives that require coordination across several dimensions, such as financial planning, healthcare, personal and professional development, etc. Burkey, col. 28, ll. 38-43. "From the time a demand for products or services is entered, to the completion of payment, intelligent agents are utilized to conduct research, execute transactions and provide advice." Burkey, col. 28, ll. 46-49. Burkey is directed to buying products or services. There is no suggestion in Burkey to generate financial payment advice as set forth in claim 1.

It was unclear to which elements of claim 1 the 2002 Office action referred. This ambiguity remains in the recent Office action. In the Office action, it is acknowledged that Burkey does "not mention explicitly a second GUI displayed on the display of the computer having descriptive icons representing one or more financial situations such as financial payments and etc." This is not the claim language. The Examiner has based the rejection on a phrase not found in the claims, but confusingly incorporates features of at least three claim elements. This rejection based on the Examiner's summary construction of the claim language is impermissible. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970), *See also* M.P.E.P § 2143.03 (8<sup>th</sup> Ed. Rev. 1 2003)("All Claim Limitations Must Be Taught or Suggested"). Claim 1 sets forth that the first GUI comprises descriptive icons representing one or more financial situations. The processor recited in claim 1 is operative to generate financial payment advice. At least the following claimed elements are not suggested by Burkey: 1) a first GUI *comprising one or more descriptive icons representing one or more financial situations*, 2) *a second GUI*, and 3) a processor operative to *generate financial payment advice*. There is no suggestion or motivation found in the prior art to modify Burkey to include these elements.

As discussed above, "when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." *In re Kotzab*, 217 F.3d at 1370, 55 U.S.P.Q.2d at 1316-17. There is no motivation to modify the teaching of Burkey as suggested in the Office action. The Office action is silent regarding a motivation to modify Burkey to include a GUI comprising one or more descriptive icons *representing one or more financial situations*. One of ordinary skill would have had no motivation to modify Burkey to include icons representing financial situations. With regard to a second GUI, in the Office action it is asserted "it would have been obvious to one having

ordinary skill in the art at the time the invention was made to modify the system, as taught by Burkey et al., to have a second set of GUI since it is well-known in the art that it is simple to duplicate the existing set of GUIs for another one.” The Examiner again fails to consider the language of the claim. Claim 1 does not set forth two duplicate GUIs. To the contrary, the first and second GUIs each have particular properties related to applicants’ system. Accordingly, one motivated to duplicate GUIs could not arrive at a system with the second GUI as set forth in claim 1 by duplicating any teaching of Burkey. There is simply no motivation found in the prior art to modify Burkey to include a second GUI comprising one or more questions as set forth by claim 1. With regard to the processor, in the Office action it is asserted “it would have been obvious to one skilled artisan to add a means for generating financial payment advice in Burkey et al. system by adding additional application software.” The Office action includes no support for this broad conclusory statement. “Broad conclusory statements standing alone are not evidence.” *Id.* at 1370, 55 USPQ2d at 1317. There is no explanation in the prior regarding how to add additional application software to the Burkey system to generate financial payment advice as suggested in the Office action. As Burkey is not directed to providing financial payment advice, there is no suggestion to modify Burkey in the manner suggested in the Office action.

The 2002 Office action did not address each element of claim 1. The recent Office action fails to correct this deficiency of the rejection. As discussed above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested. M.P.E.P. § 2143.03 (8<sup>th</sup> Ed. Rev. 1 2003). The Office action fails to consider that the second GUI is displayed based on selection of one of the descriptive icons. The Office action also does not consider that the second GUI comprises one or more questions. It is acknowledged in the Office action that Burkey fails to show a second GUI. There is no suggestion to modify Burkey to include a second GUI that is displayed based on the selection of a descriptive icon and that comprises one or more questions.

Applicants respectfully submit that for at least the above reasons Burkey fails to show or suggest each limitation of claim 1. The Office action fails to establish a *prima facie* case of obviousness against claim 1, because there is no motivation found in the prior art to modify Burkey as suggested in the Office action and because Burkey, even if modified as suggested, fails to teach or suggest all the claim limitations. Accordingly, applicants request that the rejection of claim 1 as being unpatentable in view of Burkey be withdrawn.

Claims 2-7 depend from claim 1 and accordingly include all the limitations of claim 1. If an independent claim is nonobvious over the prior art, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 2-7 are thus patentable over Burkey for at least the reasons discussed above with respect to claim 1.

In addition, proposed claim 3 sets forth that the system is operable to generate advice on negotiation strategies regarding an individual's economic situation for interacting with the individual. In the Office action, it is acknowledged that Burkey does not show this element. In the Office action, it is noted that Burkey tangentially addresses advice across several dimensions of fundamental life needs including financial planning. On this basis, the Office action asserts "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, as taught by Burkey et al., to generate advice on negotiation strategies for interacting individual." Burkey does not address negotiation strategies. The mere mention of financial planning by Burkey is insufficient to render the generation of negotiation strategies obvious to one of ordinary skill in the art. There is simply no suggestion or motivation, outside applicants' own specification, to modify Burkey to generate advice on negotiation strategies.

Claim 3 is proposed to be amended to expressly set forth that the negotiation strategies regard an individual's economic situation. In the Office action in response to applicants' 2003 response, it is asserted "that the current claimed invention (recited in claims 1-16) does not recite 'a negotiation advice to a customer service representative regarding an individual's economic situation.'" Although applicants believe this statement by the Examiner is based on an excessively limited view of the claim language and applicants prior arguments, applicants propose to amend claim 3 to expressly set forth that the negotiation advice does regard an individual's economic situation.

Claim 4 sets forth that the second GUI comprises predetermined questions or predetermined answers to predetermined questions. In the Office action, it is acknowledged that Burkey does not show this element. It is noted in the Office action that Burkey recognizes the development of graphical user interfaces. On this basis, the Office action asserts "it would have been obvious to one skilled artisan in the art to modify the GUI's taught by Burkey et al., to have predetermined questions and predetermined answers to the predetermined questions." This is a

broad conclusory statement that standing alone cannot establish *prima facie* obviousness. Burkey merely acknowledges the development of graphical user interfaces. Burkey, col. 6, ll. 60-64. This acknowledgement provides no motivation or suggestion to modify Burkey to include a second GUI having the properties defined by claim 4. There is no suggestion found in the prior art to modify any GUI in Burkey to include predetermined questions or predetermined answers to predetermined questions.

Claim 7 sets forth that the second GUI comprises means for specifying the type of the advice generated by the system. In the Office action, it is acknowledged that Burkey does not show this element. It is noted that Burkey teaches specific GUIs. It is thus asserted “it would have been obvious to one having ordinary skill in the art to modify each GUI having a means for specifying the type of advice.” To the contrary, Burkey does not deal with types of advice and, thus, there is no suggestion or motivation to modify Burkey as suggested in the Office action.

For at least the above reasons, the Office action fails to present a *prima facie* case of obviousness against claims 2-7. Applicants respectfully request for at least the above reasons that the rejections of claims 2-7 be withdrawn.

## **2) Independent Claim 8 and Claims Dependent Therefrom**

In the Office action, it is asserted that claim 8 contains features addressed in the above paragraphs, and therefore, claim 8 is rejected under the same rationale. The Office action fails to establish a *prima facie* case of obviousness against claim 8. Claim 8 sets forth a method of providing financial payment advice specifically tailored to an individual’s economic situation.

Burkey fails to suggest the following steps of claim 8 for the reasons similar to those set forth above with respect to claims 1-7:

retrieving strategy data in response to the selection of a descriptive icon, said descriptive icon *representing one financial situation*;

displaying a *second GUI* on said display, said second GUI comprising *one or more questions*;

processing answers to questions generated by said system *in response to said selection of said descriptive icon, said questions related to said financial situation*;

retrieving *financial payment advice data related to said answers to said questions*; and

displaying *said financial payment advice* on said display.

Burkey fails to show or suggest these elements for the reasons acknowledged in the Office action with respect to claim 1. There is no motivation found in the prior art to modify Burkey to include these elements.

In the Office action, it is acknowledged that Burkey does “not mention explicitly a [sic] steps of retrieving strategy data in response to an individual’s account information.” More specifically, Burkey fails to show or suggest the following steps of claim 8:

retrieving *the individual’s account information*;

displaying *the account information* on a first graphical user interface; and

retrieving *strategy data in response* to the selection of a descriptive icon.

It is asserted, in the Office action, that Burkey teaches a system that is capable of retrieving information from multiple databases according to an individual’s profile. It is further asserted, “Therefore, it would have been obvious to one skilled artisan to understand that the system, as taught by Burkey et al., is capable of retrieving information and/or strategy data in response the selection of a descriptive icon.” To the contrary, Burkey suggests no strategy data and, thus, is not capable of retrieving strategy data without modification. The mere fact that Burkey can be modified does not render claim 8 obvious, because there is no suggestion of the desirability of the modification except in applicants’ own specification. “Although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” M.P.E.P. § 2143.01 (8<sup>th</sup> Ed. Rev. 1 2003)(quoting *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432). There is no suggestion or motivation found in the prior art to modify Burkey to retrieve an individual’s account information or strategy data as set forth in claim 8.

For at least the above reasons, the Office action fails to present a *prima facie* case of obviousness against claim 8. Applicants respectfully request that for at least the above reasons the rejection of claim 8 as being unpatentable in view of Burkey be withdrawn.

Claims 9 and 10 depend from claim 8 and accordingly include all the limitations of claim 8. If an independent claim is nonobvious over the prior art, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 9 and 10 are thus patentable over Burkey for at least the reasons discussed above with respect to claim 8.



In addition, proposed claim 9 sets forth the step of generating advice on negotiation strategies regarding an individual's economic situation for interacting with the individual. Claim 9 is rejected for the same reason as claim 3. There is no suggestion or motivation, outside applicants' own specification, to modify Burkey to generate advice on negotiation strategies for the reasons set forth above with respect to claim 3. Claim 9 is amended for similar reasons to those explained above with respect to claim 3.

Claim 10 sets forth the step of displaying the advice together with the questions. In the Office action, it is asserted that claim 10 addresses features addressed in claim 4. Claim 10 is thus rejected on the same rationale. The rationale set forth in the Office action with regard to claim 4 is that Burkey recognized the development of graphical user interfaces. Burkey, however, fails to show or suggest displaying advice with questions as set forth by claim 10.

For at least the above reasons, the Office action has failed to establish a *prima facie* case of obviousness against claims 9 and 10. Applicants respectfully request for at least the above reasons that the rejections of claims 9 and 10 be withdrawn.

### **3) Independent Claim 11 and Claim Dependent Therefrom**

It is asserted in the Office action that claim 11 contains features addressed in the above claims, and therefore, is rejected under the same rationale. This statement is insufficient to establish a *prima facie* case of obviousness against claim 11. The Office action has failed to consider the specific language of claim 11. "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). The Office action has failed at least to ascertain the differences between the prior art and claim 11, as the specific language of claim 11 is not addressed.

Claim 11 sets forth a method for providing financial payment advice specifically tailored to an individual's economic situation. Burkey fails to show or suggest the following steps of the method of claim 11:

obtaining information related to the *individual's financial account*;  
*classifying the individual's economic situation*;

selecting a descriptive icon, the descriptive icon *representing one financial situation*, where the descriptive icon is displayed on a first graphical user interface (GUI) displayed on a display of a computer;

*obtaining answers to questions offered in response to the selection of the descriptive icon, the questions displayed on the first GUI where the questions are related to the financial situation*;

inputting *the answers* to said questions; and

*requesting financial payment advice* based on at least said answers to said questions.

In the Office action, it is asserted “it would have been obvious to one skilled in the art the modify the GUI’s, as taught by Burkey et al., to have predetermined questions and predetermined answers to the predetermined questions and later to refine the answers and/or advice.” This statement fails to explain how the Examiner suggests that Burkey be modified so as to arrive at the method set forth by claim 11. Furthermore, there is no suggestion found in the prior art to modify any GUI of Burkey as suggested by the Office action.

For at least the above reasons, the Office action fails to establish a *prima facie* case of obviousness against claim 11. Applicants respectfully request that for at least the above reasons the rejection of claim 11 as being unpatentable in view of Burkey be withdrawn.

Claim 12 depends from claim 11 and accordingly includes all the limitations of claim 11. If an independent claim is nonobvious over the prior art, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claim 12 is thus patentable over Burkey for at least the reasons discussed above with respect to claim 11.

Claim 12 sets forth specifying the type of the advice generated by the system. In the Office action, it is acknowledged that Burkey does not show this limitation. Claim 12 is rejected for the same reasons as claim 7. Burkey fails to suggest the additional step of claim 12 for at least the reasons discussed above with respect to claim 7.

Applicants respectfully request for at least the above reasons that the rejection of claim 12 be withdrawn.

#### 4) Independent Claim 13 and Claims Dependent Therefrom

In the Office action, it is asserted that claim 13 contains features addressed in previous claims, and therefore, is rejected under the same rationale. This statement is insufficient to establish a *prima facie* case of obviousness against claim 13. The Office action has failed to consider the specific language of claim 13. As discussed above, “[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). The Office action has failed at least to ascertain the differences between the prior art and claim 13, as the specific language of claim 13 is not addressed.

Claim 13 sets forth a system for providing financial payment advice specifically tailored to an individual’s economic situation. Burkey fails to suggest at least the following steps of claim 13 for reasons similar to those set forth above with respect to claim 1:

a graphical user interface (GUI) displayed on said display of said computer, said GUI comprising one or more descriptive icons, *said descriptive icons representing one or more financial situations*;

means for *generating financial payment advice* based at least in part on said information specific to said individual.

Burkey fails to show these elements for the reasons acknowledged in the Office action with respect to claim 1. There is no motivation found in the prior art to modify Burkey to include these elements. The unsupported statements in the Office action that it would have been obvious to modify Burkey to include the similar elements set forth in claim 1 are insufficient to establish a *prima facie* case of obviousness for the reasons discussed above.

For at least the above reasons, the Office action fails to establish a *prima facie* case of obviousness against claim 13. Applicants respectfully request that, for at least the above reasons, the rejection of claim 13 as being unpatentable in view of Burkey be withdrawn.

Claims 14-16 depend from claim 13 and accordingly include all the limitations of claim 13. If an independent claim is nonobvious over the prior art, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 14-16 are thus patentable over Burkey for at least the reasons discussed above with respect to claim 13.

In addition, proposed claim 14 sets forth means for generating advice on negotiation strategies regarding an individual's economic situation for interacting with the individual. Claim 14 is rejected for the same reasons as claim 3. There is no suggestion or motivation, outside applicants' own specification, to modify Burkey to generate advice on negotiation strategies for the reasons set forth above with respect to claim 3. Proposed claim 14 is amended for reasons similar to those explained above with respect to claim 3.

Claim 15 sets forth means for specifying the type of the advice generated by the system. Claim 15 is rejected for the same reasons as claim 7. Burkey fails to suggest the additional element of claim 15 for the reasons discussed above with respect to claim 7.

Claim 16 sets forth that the system further comprises means for further refining the advice. It is asserted in the Office action that claim 16 contains features addressed in the above claims. Claim 16 is therefore rejected under the same rationale. It is noted in the Office action that Burkey recognizes the development of graphical user interfaces. On this basis, it is asserted that it would have been obvious to one skilled in the art to modify the Burkey GUIs and later to refine the answers and/or advice. The recognition of the development of GUIs is insufficient to establish any motivation to modify Burkey to include any means to further refine advice.

For at least the above reasons, the Office action fails to present a *prima facie* case of obviousness against claims 14-16. Applicants respectfully request for at least the above reasons that the rejections of claims 14-16 be withdrawn.

#### **D. RESPONSE TO ARGUMENTS**

In Section 3 of the Office action, applicants' arguments from the 2003 Response are considered. Applicants' numerous and detailed statements pointing out the many errors in the 2002 Office action are summarized in the following single sentence. "Applicant indicated that the system, as taught by Burkey et al., does not provide negotiation advice to a customer service representative regarding an individual's economic situation." In response, the Examiner takes the opportunity to point out that the current claimed invention does not recite "a negotiation advice to a customer service representative regarding an individual's economic situation." Applicants propose to amend claims 3, 9, and 14 to expressly set forth generation of advice on negotiation strategies regarding an individual's economic situation for interacting with the individual. Applicants maintain that the 2003 Response distinctly and specifically pointed

out errors in the 2002 Office action. Applicants submit that any inapplicability of those arguments to the pending claims will be obviated by the proposed amendments to claims 3, 9, and 14.

The Office action asserts that applicants' arguments set forth in the 2003 Response have been addressed in the instant Office action. Applicants find this statement to be disingenuous. As noted above, the rejections of claims 1-10 and 12-15 are identical to the rejections set forth in the 2002 Office action. The only error from the 2002 Office action that is corrected by the instant Office action is that claims 11 and 16 have been addressed in the recent prior art rejection. None of applicants' other numerous and detailed arguments set forth in the 2003 Response are addressed in the recent Office action.

### III. CONCLUSION

The Office action has presented a new ground of rejection against claims 11 and 16 that was not necessitated by amendments to the claims. Accordingly, applicants request that the finality of the Office action be withdrawn as premature.

The rejection of all pending claims as being unpatentable over Burkey fails to establish a *prima facie* case of obviousness against any of the pending claims. The Office action acknowledges that Burkey fails to teach each limitation of the pending claims, but fails to point to any motivation found in the prior art to modify Burkey to arrive at the invention as claimed by the pending claims. Reconsideration of the application and allowance of the pending claims are respectfully solicited.

Should the Examiner require resolution of any issues for allowance, the Examiner is invited to contact the undersigned to expedite the prosecution of this application to final action.

Respectfully submitted,

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